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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,986	07/20/2001	Roger K. Stone	0585MH-41322	3507

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EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,986

Applicant(s)

Stone

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 35-43 have been renumbered (Rule 1.126) as claims 34-42.

This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

There is no residence provided for the inventor.

Claims 1-42 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

The preliminary amendment filed 09/23/02 proposes amendments to the claims (amended claims must be underlined in their entirety) that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 35-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 line 23, "said a" renders the claim indefinite.

Claim 37 line 4, the first occurrence of "surface" appears to be incorrect.

Claim 37 line 4, "and operates" is confusing because it is not clear what is doing the operating.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

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In the present instance, claim 37 line 7 recites the broad recitation foreign matter, and the claim also recites paraffin which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 38 line 6 recites the broad recitation foreign matter, and the claim also recites paraffin which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-5, 7-11, 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Humason (US 2134045).

Humason discloses a producing well having at least a production tube string (1) and a sucker rod string ((25,33), see Figs. 1-7) disposed generally concentrically therein and comprising in combination a well treatment tool (27,28) having a generally cylindrical body for installing concentrically in line with said sucker rod string and for distributing well treatment fluid from said sucker rod string and into said production tube string (see Figs. 1, 5), with said sucker rod string including at least a hollow portion disposed above said cylindrical body; said body of said well treatment tool including an upper end having an axial fluid entrance passage therein for accepting treatment fluid from said sucker rod portion disposed there above, and an opposite solid lower end; said body of said well treatment tool further including at least one treatment fluid distribution passage extending outwardly from said body of said well treatment tool ((40), see col. 2 line 37+); valve means (27) including an inlet end communicating with said fluid entrance passage and opposite outlet end communicating with said fluid distribution passage; and attachment means disposed upon said upper end and said lower end of said body of said well treatment tool , for attaching said body to said sucker rod string (see Fig. 1). There is a production fluid passage between the production tube string and the well treatment tool (see Fig. 1). The valve means is a check valve (27). The fluid distribution passage is a plurality of passages (40). The upper end and lower end of the well treatment tool body are externally threaded (see Fig. 1).

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5. Claims 1-4, 6, 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris et al. (US 4694908).

Morris et al. discloses a producing well having at least a production tube string (12) disposed generally concentrically therein and comprising in combination a well treatment tool (18) having a generally cylindrical body for installing concentrically in line with a treatment fluid string (16) and for distributing well treatment fluid from said treatment fluid string and into said production tube string (see col. 3 line 15+), with said treatment fluid string including at least a hollow portion disposed above said cylindrical body; said body of said well treatment tool including an upper end having an axial fluid entrance passage therein for accepting treatment fluid from said treatment fluid string; said body of said well treatment tool further including at least one treatment fluid distribution passage extending outwardly (26) from said body of said well treatment tool; valve means (28,32) including an inlet end communicating with said fluid entrance passage and opposite outlet end communicating with said fluid distribution passage; and attachment means (22) for attaching said body to said treatment fluid string. There is a production fluid passage between the production tube string and the well treatment tool (see Figs. 1,2). The valve means is a check valve (32). The fluid distribution passage is a plurality of passages ((26), see col. 3 line 49)). The upper end and lower end of the well treatment tool body are internally threaded (see Fig. 2).

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humason.

Humason discloses the invention substantially as claimed. However, Humason lacks for the upper end and lower end of the well treatment tool body to be internally threaded. It should be noted that applicant has not provided the criticality of having the upper end and lower end of the well treatment tool body be internally threaded and since externally threaded members and internally threaded members are well known and old in the art; it would have been considered obvious to one of ordinary skill in the art to modify Humason by having the upper end and lower end of the well treatment tool body be internally threaded since this is a mere design choice.

8. Claims 13-19, 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humason in view of applicant's admission of prior art (see US 5924490, col. 1 line 54+).

Humason discloses the invention substantially as claimed. However, Humason is silent about the production fluid going to a treatment and storage system. Applicant admits that it is

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conventional for production fluid to go to a treatment and storage system (see US 5924490, col. 1 line 54+). It would have been considered obvious to one of ordinary skill in the art to modify Humason to include the step of having the production fluid go to a treatment and storage system since such step is conventional as admitted by applicant.

With regards to claim 19, Humason lacks for the upper end and lower end of the well treatment tool body to be internally threaded. It should be noted that applicant has not provided the criticality of having the upper end and lower end of the well treatment tool body be internally threaded and since externally threaded members and internally threaded members are well known and old in the art; it would have been considered obvious to one of ordinary skill in the art to modify Humason by having the upper end and lower end of the well treatment tool body be internally threaded since this is a mere design choice.

9. Claims 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humason in view of applicant's admission of prior art (see US 5924490, col. 1 line 54+) as applied to claims 13 and 29 respectively above, and further in view of Morris et al. (US 4694908).

Humason (once modified) discloses the invention substantially as claimed. However, the (once modified) Humason is silent about the treatment fluid being a paraffin solvent and the production fluid is oil with a paraffin component. Morris et al. teaches treatment fluid being a paraffin solvent (see col. 1 line 21+) which implies the production fluid is oil with a paraffin component. It would have been considered obvious to one of ordinary skill in the art to modify the (once modified) Humason by having the treatment fluid be a paraffin solvent and the

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production fluid oil with a paraffin component since the well can produce oil without stopping production (see Morris et al. '908 col. 4 lines 9-11).

10. Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. in view of applicant's admission of prior art (see US 5924490, col. 1 line 54+).

Morris et al. discloses the invention substantially as claimed. However, Morris et al. is silent about the production fluid going to a treatment and storage system. Applicant admits that it is conventional for production fluid to go to a treatment and storage system (see US 5924490, col. 1 line 54+). It would have been considered obvious to one of ordinary skill in the art to modify Morris et al. to include the step of having the production fluid go to a treatment and storage system since such step is conventional as admitted by applicant.

11. Claims 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humason in view of Soderberg (US 4681167).

Humason discloses the invention substantially as claimed. However, Humason is silent about having a treatment fluid supply tank, a treatment fluid line connecting to the supply tank, a pump coupled to the treatment fluid line, intermittently supplying the treatment fluid, wherein the treatment fluid prevents the accumulation of paraffin and separation/storage equipment for receiving the wellbore fluids. Soderberg teaches a treatment fluid supply tank, a treatment fluid line connecting to the supply tank, a pump coupled to the treatment fluid line (see Fig. 10), intermittently supplying the treatment fluid (see col. 3 line 60+), wherein the treatment fluid prevents the accumulation of paraffin (see col. 1 line 20) and separation/storage equipment (see

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col. 5 line 14) for receiving the wellbore fluids. It would have been considered obvious to one of ordinary skill in the art to modify Humason to include a treatment fluid supply tank, a treatment fluid line connecting to the supply tank, a pump coupled to the treatment fluid line, intermittently supplying the treatment fluid, wherein the treatment fluid prevents the accumulation of paraffin and separation/storage equipment for receiving the wellbore fluids as taught by Soderberg since such equipment and steps would ensure that the recovery of oil would not decrease due to wax/paraffin build up.

12. Claims 35-38 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. '908 in view of Soderberg (US 4681167).

Morris et al. discloses the invention substantially as claimed. However, Morris et al. is silent about having a treatment fluid supply tank, a treatment fluid line connecting to the supply tank, a pump coupled to the treatment fluid line, intermittently supplying the treatment fluid and separation/storage equipment for receiving the wellbore fluids. Soderberg teaches a treatment fluid supply tank, a treatment fluid line connecting to the supply tank, a pump coupled to the treatment fluid line (see Fig. 10), intermittently supplying the treatment fluid (see col. 3 line 60+) and separation/storage equipment (see col. 5 line 14) for receiving the wellbore fluids. It would have been considered obvious to one of ordinary skill in the art to modify Morris et al. to include a treatment fluid supply tank, a treatment fluid line connecting to the supply tank, a pump coupled to the treatment fluid line, intermittently supplying the treatment fluid and separation/storage

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equipment for receiving the wellbore fluids as taught by Soderberg since such equipment and steps are conventionally used in the recovery of oil.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Sunil Singh



Patent Examiner

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11/15/02